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Supreme Court of the United States

OCTOBER TERM, 1953

No. 605

GEORGE WASHINGTON PIERCE,
Petitioner,

vs.

AMERICAN COMMUNICATIONS COMPANY, INC.,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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GEORGE WASHINGTON PIERCE,

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vs.

AMERICAN COMMUNICATIONS COMPANY, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

The Petition Is Without Merit

Under the guise of presenting novel and important questions of law, Petitioner seeks to reargue his case in an ordinary suit for alleged patent infringement.

The Court of Appeals for the First Circuit held patent 2,133,642 to Petitioner (R. 531a; hereinafter designated by its last two digits, 42) unenforceable against Respondent who practiced the invention as described and claimed in an earlier and expired patent to Petitioner, No. 1,789,496 (R. 593a; hereinafter referred to by its last two digits, 96).

Petitioner's argument is the same as the one which the District Court had erroneously accepted but the Court of

Appeals had rejected; that via patent 42 he had obtained in effect a valid and enforceable extension of the seventeen years' monopoly which he had enjoyed under patent 96.

The Pierce oscillator circuit arrangement was allegedly invented in 1923 (R. 519a). Patent 96 not only described the Pierce oscillator circuit used in a (radio) transmitting and receiving system but, as held below (R. 671a) and conceded (Petition, 6, 44), claimed it also in at least one of its claims (claim 2).

The issuance of patent 96 did not take place until 1931, more than seven years after the invention was made. The patent expired in 1948 and Petitioner collected a million dollars (Pet. p. 3) and other rewards (R. 508a-529a) during the seventeen years life of patent 96.

In 1950, two years after the expiration of patent 96, Respondent started as a public service company (R. 165a-168a) employing a radio transmitting and receiving system for two-way communication for taxi cabs and other vehicles. The accused radio system was constructed precisely as described and claimed in the expired patent 96, employing a great many instrumentalities, including two Pierce oscillator circuits, precisely as claimed in claim 2 of that patent (Pet. pp. 5, 6; R. pp. 110a, 152a-158a).

In 1938 Petitioner obtained a group of patents having claims of varying scope on the same Pierce oscillator circuit, including patent 42 claiming the Pierce oscillator circuit in any and all systems. These patents contained more than 350 claims (patent 42 alone has 106) which were granted undoubtedly because by their sheer multiplicity they obscured the fact that they claimed over and over again what was claimed in patent 96. Petitioner contends that patent 42 extends his monopoly in the use of the Pierce oscillator circuit in radio transmitting and receiving sys-

tems until 1955, more than seven years after the expiration of patent 96. Respondent was sued on six of these patents in 1951 (R. 2a), the same circuit detail of the radio transmitter and receiver being accused under all (R. 12a, 13a, 16a-19a).

This Court has never sanctioned such extension of patent monopoly beyond the statutory seventeen years. The decision of the court below is not at variance with the law as established in any circuit; aberrations or misunderstandings were promptly corrected by this Court and the Courts of Appeals themselves.

The Two Pierce Patents Are Not for a Combination and an Element of the Combination: Both Are for Combinations of Old Components, Patent 42 Claiming More Broadly the Combination Specifically Claimed in Patent 96

Petitioner argues as he did below that patent 96 is for a combination of elements, and patent 42 for a single element of the combination. Even if this were so, the decisions of this Court and *Palmer* v. *Lozier* (*infra*, p. 11) would prevent enforcement of 42 after the expiration of 96. However, Petitioner's assertions are at variance with the facts.

As will be apparent from the analysis of the claims in the opinion below (pp. 674a, 675a), both patents are for combinations of old elements.[1] In patent 42 the combination claimed is any electro-mechanical system and the old

1. The District Court found (R. 464a, 473a):

> "Pierce was not, of course, the first to connect a piezo-electric crystal into an oscillating circuit or to use it to establish some control over the frequency of the oscillations . . . Pierce did not claim to invent the vacuum tube or the vacuum tube oscillation generator."

components of the Pierce oscillator circuit, and in claim 2 of expired patent 96 the combination claimed is a transmitter and receiver system and the old components of the Pierce oscillator circuit. Thus the claims of the two patents are for combinations, differing only in scope.

We note that originally Pierce tried to obtain claims for any oscillator circuit combination with any transmitting and receiving system. However, as is clear from the claims of patent 96, he was compelled to alter those claims to their present form.[2] The same Pierce oscillator circuit is covered by claim 2 of patent 96 as by the claims (*e. g.*, 42, 67) of patent 42.

The Question Presented

The question presented by this case is whether Respondent's accused radio transmitter and receiver system which is constructed precisely as described and claimed in Pierce's expired patent 96,

(a) is covered by Pierce's later issued patent 42; and

(b) if patent 42 can be enforced against Respondent, whether it is valid.

2. The facts are more fully stated in Appendix I.

ARGUMENT

The decision below did not establish a new rule of law, but decided the case on the authority of this Court, as well as of the Courts of Appeals of the First, Second and Sixth Circuits and the Court of Customs and Patent Appeals.

The validity of patent 42 has not been admitted.

Petitioner's often repeated statement to the contrary notwithstanding (pp. 8, 9, 25), patent 42 is not "admittedly valid". The court below, having answered the first portion (a) of the question negatively, *i. e.* that patent 42 could not be enforced against Respondent (R. 679a), refrained from categorically answering portion (b) of the question. Had the answer to (a) been positive, we are confident that the Court of Appeals would have held patent 42 invalid or not enforceable on one or more of the other grounds which Respondent had urged below and, should the petition be granted, begs leave to urge in this Court.[3]

The law is well established that a patentee cannot extend the monopoly of a patent by taking out a second patent.

The leading case is *Miller* v. *Eagle Manufacturing Co.*[4] In that case, Wright (the inventor) just as Petitioner, an-

3. Laches estops Petitioner to enforce his rights against Respondent.
Patent 42 is invalid because of
(1) double patenting;
(2) the state of the art (Cady and Nicolson);
(3) the claims do not satisfy the statutory requirement that they be distinct; they are unduly multiplied and functional; and
(4) the commercial background does not help to establish validity, and contemporaneous contriving by others and dilatory proceedings in Patent Office indicate invalidity.

4. 151 U. S. 186, sometimes cited as *Miller* v. *Manufacturing Co.*, or *Miller* v. *Eagle*.

ticipating an interference with others, filed a divisional application on specific claims and left the broad claims in the parent application. On account of the interference, the later filed divisional application issued first and the parent application a year and a half later. Rejecting the contention that the Patent Office requirement to divide absolved the patentee, this Court said at pages 198-199:

> "It is insisted on the part of the appellee that 'whether this invention shall be protected in part of its features by one patent, and as to the rest by another, or shall be completely protected by a single patent, is a matter which concerns solely the Patent Office and the inventor.' Under the rule announced in the foregoing authorities this proposition cannot be sustained."[5]

This Court also said (at p. 198):

> "The result of the foregoing and other authorities is that no patent can issue for an invention *actually covered* by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a *broader claim,* more generical in its character, than the *specific claims* contained in the prior patent, is also void; but that where the second patent covers matter described in the prior patent essentially distinct and separable from the invention covered thereby, and claims made thereunder, its validity may be sustained.
>
> "In the last class of cases it must distinctly appear that the invention covered by the later patent was *a separate invention, distinctly different and in-*

5. Other cases which have held that one cannot excuse extensions of monopoly by pleading that they were the results of a requirement of the Patent Office to divide out claims are: *Western Electric Co.* v. *Galesburg Union Telephone Co., et al.,* 148 Fed. 857 N. D. Ill. (affirmed 144 Fed. 684, CCA 7); *Industrial Mfg. Co.* v. *Wilcox & Gibbs Sewing Machine Co.,* CCA 3, 112 Fed. 535; and *Western Electric* v. *Williams-Abbott Electric Co.,* 108 Fed. 952, CCA 6.

> *dependent from that covered by the first patent;* in other words, it must be something substantially different from that comprehended in the first patent. It must consist in *something more than a mere distinction of the breadth or scope of the claims* of each patent. If the case comes within the first or second of the above classes, the second patent is absolutely void."[6]

The court below correctly understood and applied *Miller* v. *Eagle* whose principles were reasserted and applied by this Court in the *Saranac* case[7] to a factual situation much more favorable to the patentee than are the facts of this case to Petitioner. There is no justification for Petitioner's assertion (see *e. g.* p. 11) that the court below misunderstood the *Saranac* case or relied on *dicta.* The passages of the *Saranac* case to which we shall refer, as we did in the court below, were not *dicta;* they fairly arose, and were properly presented and decided. (*Union Pac. R. Co.* v. *Mason City & Ft. Dodge R. Co.,* 199 U. S. 160, 166; *Florida C. R. Co.* v. *Schutte,* 103 U. S. 118, 143.)

The *Saranac* case was a suit for infringement of three patents issued on the same day to Inwood and Lavenberg as joint inventors: (1) Machine for making box blanks; (2) a work holder used in the making of the box blanks; and (3) method of making boxes, filed as a division of

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6. Emphasis supplied throughout this brief.

In applying this rule of law to the specific situation which confronts Petitioner, Judge COXE, speaking for the Court of Appeals of the Second Circuit (*Gold* v. *Gold,* 187 Fed. 273, 274), said:

> "In other words, a new patent with broad claims will extend the monopoly of the earlier patent with more restricted claims. That the proposed claims are generic and the existing claims restricted is alleged repeatedly in the bill. *We see no answer to the proposition that the proposed patent would be void for double patenting.* If the facts alleged in the bill be correct, the claims of the new patent, if issued, will cover the specific devices covered by the claims of No. 771,628, which devices the public have a right to use immediately after the expiration of that patent."

7. *Saranac Automatic Machine Corporation* v. *Wirebounds Patent Company,* 282 U. S. 704.

patent (2). An expired patent (4) to Inwood and Lavenberg covered a specific form of box blanks which could be made with or without the use of the machine, work holder and method patents (1-3).

The defendants contended that although they employed patents (1-3) to make the specific box blanks covered by the expired patent (4), patents (1-3) could not be enforced against them because that would extend the monopoly of the expired patent (4) by ten years. This contention was rejected by the Court of Appeals of the Sixth Circuit (37 F. 2d 830) which held, per DENISON, *C. J.* (at p. 837):

> "These Thompson-Ohio Cases[8] have been frequently followed and applied, and we think the rule is now universally accepted that, as to typical and properly separable generic and specific patents, the incidental extension of the smaller monopoly does not affect the validity of either patent."

Petitioner's case is bottomed on this holding and the *Thomson-Ohio* cases, notwithstanding the fact that it was reversed by this Court when Mr. Justice STONE wrote in the *Saranac* case (at p. 709):

> "As it has now expired, the public is free to use the new procedure of making wirebound folding box blanks so far as taught by that patent."

Again, at page 715:

> "It is the attempted extension of the monopoly of the expired reissue patent [4] in Inwood and Laven-

8. *Thomson-Houston Electric Co.* v. *Elmira* (71 Fed. 396, 405 (CCA 2, WALLACE, *C.J.*); *Thomson-Houston* v. *Ohio Brass*, 80 Fed. 712, 725, 728 (CCA 6, TAFT, *C.J.*)). Petitioner relies on these and also on some of the other cases cited by Judge DENISON as authority that an inventor may extend his monopoly by securing partly overlapping broad and specific patents for an invention: *Century Electric* v. *Westinghouse* (CCA 8, 191 Fed. 350, 353); *Dayton Co.* v. *Westinghouse* (CCA 6, 118 Fed. 562, 573); *Cleveland Co.* v. *Detroit Co.* (CCA 6, 131 Fed. 853, 858); *Traitel Co.* v. *Hungerford Brass* (CCA 2, 22 Fed. 2d 259, 262).

> berg's invention by resort to the machine patent [1], and to the work holder [2] from which the described invention had been subtracted by division, and which cover, not the invention of the reissue patent [4] but a mechanical device which does not involve invention."

It would be *impossible* for Respondent to employ the combination claimed in claim 2 of the expired patent 96 without using patent 42 (R. 110a, 152a-158a). In the *Saranac* case, defendants could have made the box of the expired patent (4) without using the machine patent (1) but chose to employ the machine patent, as said by Judge DENISON (37 F. 2d 830, 838):

> ". . . to make the product cheaply enough to be marketable, . . ."

The public interest in the free use of an expired patent has been emphasized over and over again by this Court even in cases where the question of double patenting did not arise.[9]

The doctrine of the *Saranac* case that a patentee will not be permitted to extend the monopoly of his own expired patent, was carried a step further in the *Marcalus* case.[10] Mr. Chief Justice STONE held that not even the doc-

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9. In *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, Mr. Justice WHITE speaking for the Court:

> "It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows as a matter of course that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent."

Mr. Chief Justice STONE wrote in *Special Equipment* v. *Coe*, 324 U. S. 370, 378:

> "It (Congress) thus gave to the inventor limited opportunity to gather material rewards for his invention and secured to the public the benefits of full knowledge of the invention and the right to use it upon the expiration of the patent."

10. *Scott Paper Co.* v. *Marcalus Mfg. Co.*, 326 U. S. 249.

trine of estoppel by license should be permitted to interfere with the free use of an expired patent. The following are significant passages of the opinion:

> (at p. 255) "By the patent laws Congress has given to the inventor opportunity to secure the material rewards for his invention for a limited time, on condition that he make full disclosure for the benefit of the public of the manner of making and using the invention, and that upon the expiration of the patent the public be left free to use the invention."
>
> (at p. 256) "Hence *any* attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, *whatever the legal device employed,* runs counter to the policy and purpose of the patent laws."
>
> (at p. 256) "It is thus apparent that the patent laws preclude the patentee of an expired patent and all others including petitioner from recapturing *any part of the former patent monopoly;* for those laws dedicate to all the public the ideas and inventions embodied in an expired patent."
>
> (at p. 258) "The assignor has a complete defense to an action for infringement where the alleged infringing device is that of an expired patent."

The *Marcalus* case was applied by the Court of Appeals of the Second Circuit to a double patenting situation in *Lucien Lelong, Inc.* v. *Lander Co.,* 164 F. 2d 395, in which Judge CLARK said at page 397:

> "A patent is the grant of a temporary monopoly to the patentee; at its expiration all are free to use the invention."

In *Thomson-Houston* v. *Ohio Brass*[11] on which Judge DENISON's decision in the *Saranac* case was based, the

11. 80 Fed. 712; C.JJ. TAFT and LURTON, D.J. CLARK.

Court of Appeals for the Sixth Circuit made it clear, as it did later in *Thomson-Houston* v. *Jeffrey,* (101 Fed. 121) that a second patent to the same inventor could be sustained only when the first patent was for a *clearly claimed improvement,*[12] and covering an invention separate and distinct from that covered in the second patent. The holding does not apply when, as in the instant case, the first patent is a division of the second patent and the claims do not clearly define two separate and distinct inventions.

The *"Thomson-Ohio"* cases are urged by Petitioner as the authoritative pronouncements of the Sixth Circuit and as applicable to the facts of this case, although in *Palmer Pneumatic Tire Co.* v. *Lozier,*[13] which Petitioner does not discuss, the same court expressly differentiated them from a case like the present. We quote the following from pages 744-745:

> "One cannot extract an essential element of his invention from a former patent. . . . Undoubtedly, as pointed out in Miller v. Manufacturing Co., supra, if the second patent is for a distinct and separate invention, or, to put the matter in another way, has not been made integral with another invention already patented, so as to be fairly necessary to its use, it should be sustained, if the other requisite conditions exist. Such was the case in Ohio Brass Co. v. Thomson-Houston Electric Co., 54 U. S. App. 1, 26 CCA 107, and 80 Fed. 712, where the second patent, being *for an improvement* upon the subject of a prior patent to the same patentee, was held valid. Judge Taft, in delivering the opinion of this Court in that case, clearly pointed out the distinction between such a case and that of Miller v. Manufacturing Co., and it was upon that distinction that the decision was founded. *There the*

12. Patent 96 is not for an improvement of patent 42; it is a division showing the same radio transmitter and receiver system as patent 42.

13. 90 Fed. 732; C.J. Taft, D.JJ. Severns and Clark.

> *original invention could be practiced without the use of the improvement.* It continued without any improvement therefrom, and had no claim whatever to its advantages. It is evident that the patents involved in the present case fall within the rule of the cases of Lock Co. v. Mosler and Miller v. Manufacturing Co., and not that of Ohio Brass Co. v. Thomson-Houston Electric Co."

The court below relied on *Palmer* v. *Lozier* (678a), and also on *Otis Elevator Co.* v. *Portland Co.*, CCA 1, 127 Fed. 557 (676a, 678a), in which it had previously applied the doctrine of *Miller* v. *Eagle,* and of *Palmer* v. *Lozier* to a factual situation like the present, and concluded that defendant was free to make the structure covered by the claims of plaintiff's expired patent although plaintiff still had a patent in force with broader claims.

Petitioner asks this Court to sanction the extension via patent 42 of the seventeen years' monopoly which he was granted in patent 96, *on the strength of the decision of the Court of Appeals of the Sixth Circuit in the Saranac case and the authorities cited therein* (*supra,* footnote 8, p. 8). As he did below, Petitioner seeks to drown the reversal of the *Saranac* case by this Court and the devastating holding of the Sixth Circuit in *Palmer* v. *Lozier* in an ocean of inept legal principles culled from two dozen citations. These are briefly discussed in Appendix II, *infra.*

Patent 96 Is Not for an Improvement of 42

As we have shown (*supra,* p. 6, footnote 5) the fact that Pierce had to file a divisional application does not excuse the extension of the monopoly of patent 96 by 42. Patent 96 is not an improvement on patent 42;[14] it is a division,

14. Thus making the holding in *Thomson-Houston* v. *Ohio Brass* inapplicable.

a mere amendment of 42, describing and claiming the same invention.[15] Pierce was under no compulsion to rush his divisional application through the Patent Office; he could have waited to file the application for patent 96 until 1938, when the application for patent 42 was ready to issue, and thus have insured that patent 42 with the broad claims issue ahead of patent 96. There would have been no risk in the delay, for a divisional application gets the full benefit of the earlier filing date of the parent application.[16]

Having elected to take out patent 96 in 1931, Petitioner should not now be heard to complain that his monopoly on the Pierce oscillator circuit for which he collected one million dollars during the seventeen years life of patent 96, can no longer be enforced against Respondent who employs the circuit in the transmitter and receiver system described and claimed in expired patent 96.

The New Patent Act Did Not Change the Rule of Law That Two Patents to the Same Person on a Single Invention Could Not Both Be Valid

This is a point which Petitioner had first mentioned, but then dropped in both courts below. It was, therefore, ignored in the opinions.

The new Patent Act codified existing law under which all patents issued by the Patent Office were subject to the scrutiny of the courts as to their validity.[17] This applies

15. *Dwight & Lloyd Sintering* v. *Greenawalt*, CA 2, 27 F. 2d 823, 831; *The Chicago & Northwestern* v. *Thomas Sayles*, 97 U. S. 554. See also 69 C. J. S. section 113 "i. Divisional Applications" pages 476-479.

16. *Fessenden* v. *Wilson*, 48 F. 2d 422, 424.

17. 35 U. S. C. (1952). *General Motors* v. *Estate Stoves*, CA 6, 203 F. 2d 912; *Stanley* v. *Rockwell*, CA 3, 203 F. 2d 846; *New Wrinkle* v. *Watson*, CCPA, 204 F. 2d 35.

to the entire Act including section 121 of which the annotator says:

> "This section enacts as law existing practice with respect to divisions . . ."[18]

The law as laid down in *Miller* v. *Eagle* is written into Section 121, for its first requirement is:

> "If two or more *independent* and *distinct* inventions are claimed . . ."

It cannot be doubted, therefore, that the courts would hold unenforceable or invalid a second patent which issued to one who already had a patent claiming an invention which was not "independent and distinct", whether the second patent were tested by the new or the old Patent Act.

Furthermore, the decision of the court below would stand even if patents issued under the new Act were freed from the law laid down in *Miller* v. *Eagle*, the *Saranac* case, the *Marcalus* case, *Palmer* v. *Lozier, etc.* This is so because no "requirement for restriction" was ever made in the Pierce application; the requirement of division in Pierce 42 was made on September 2, 1924, and the patent issued on October 18, 1938, long before the new Act became effective.

Section 121 of the new Act provides among other things that:

> "A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a

18. The Senate Report 1979 and House Report 1923 are to the same effect, the latter saying at page 7: "Sections 120 and 121 express in the statute certain matters which exist in the law today. . . ."

> reference either in the Patent Office or in the Courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application."

The requirement of division in Pierce 42 was not made "under this section" and the application for patent 96 was not filed "as a result of such a requirement." Therefore, even if the new statute had changed the law it would be inapplicable.

As held by the Court of Customs and Patent Appeals in *re Eisler* (203 F. 2d 726, 729):

> "Appellant's parent application matured into a patent May 25, 1948, and Section 121 became effective January 1, 1953; thus, the legislation was inapplicable to the situation presented. Manual of Patent Examining Procedure, December 10, 1952, page 2, Change Sheet, paragraph 4(b). See also In re Seebach, 88 F. 2d 722, 24 CCPA Patents, 1101."

It is immaterial that, as stated by Petitioner (p. 49) the case dealt with an application and not a patent. The statute is equally applicable to the Patent Office and to the Courts. It is similarly immaterial that, as Petitioner demonstrates (pp. 49-51) other sections of the new Act apply to all patents now in force.

CONCLUSION

For the foregoing reasons it is prayed that the petition be denied.

Respectfully submitted,

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APPENDIX I

The Origin of the Claims of Patent 96

Since Petitioner admits that the accused structures are precisely the subject matter of Pierce patent 96 whose claims read on the accused radio transmitter and receiver systems, this case is clearly within the rule of the authorities cited by us (*supra*, pp. 5-12). Petitioner's admission that the Pierce oscillator circuit is claimed in claim 2 of patent 96 is dispositive of this issue on the authorities cited.

While a single claim is enough to satisfy this point, we reject Petitioner's contention that claims 1 and 3 of patent 96 cover practically all kinds of oscillators. Pierce originally tried to get claims which broadly defined a transmitting and receiving system "having a frequency determined by an electro-mechanical vibrator", *i.e.*, any kind of electro-mechanical oscillator. The original claims 53, 54 and 57, which Pierce was required to divide out were as follows (DX 4, pp. 32, 33, and 34):

> 53. A transmitting and receiving system having, in combination, means for transmitting electric waves having a frequency determined by an electro-mechanical vibrator, and means for receiving the electric waves at a frequency determined by a second electro-mechanical vibrator, whereby beats are produced.
>
> 54. A transmitting and receiving system having, in combination, an oscillatory transmitting system, an oscillatory receiving system, each system having an electro-mechanical vibrator for determining the frequency of oscillation of the corresponding system, and means for producing beats.

> 55. A method of transmitting and receiving electric waves that comprises transmitting electric waves having a frequency determined by an electro-mechanical vibrator, and receiving the electric waves at a frequency determined by a second electro-mechanical vibrator, so as to cause beats to be produced.

These claims described combinations of old elements put together to function as *any* oscillator, and connected with a transmitting and receiving system (in which beats are produced). Such combination being old, Pierce restricted claim 2 of patent 96 to the combination of old elements put together to function as the *Pierce* oscillator circuit, *i.e.*, the invention claimed in patent 42. Similarly, the transmitting and receiving system (in which beats are produced) of claims 1 and 3 is limited to combinations of elements functioning as not just any but as a particular oscillator circuit:

> Claim 1.
>
> ". . . the connecting means being such that the local system cannot oscillate through the inherent regenerative coupling when the body is disconnected from the system, whereby the frequency of the waves of the local oscillating system is maintained substantially constant . . ."
>
> Claim 3.
>
> ". . . the connections being such as to prevent the operation of the transmitting system at other than the said substantially constant frequency . . . the connections of the second named electro-mechanical vibrator with the receiving system being such as to prevent the local oscillations at other than the second-named substantially constant frequency."

APPENDIX II

Petitioner's Miscellaneous Authorities

Suffolk v. *Hayden,* 3 Wall. 315, *Leeds and Catlin* v. *Victor,* 213 U. S. 301, *Mercoid* v. *Mid-Continent,* 320 U. S. 661, *Railroad* v. *Dubois,* 12 Wall. 47, *Special Equipment* v. *Coe,* 324 U. S. 370, *Hookless Fastener* v. *Rogers,* 26 F. 2d 264, *Scovill* v. *R. C. A.,* 9 F. Sup. 239, did not deal with the questions here in issue; they held that one may obtain a patent for a novel element as well as for a novel combination including that element, or for a combination and a subcombination. Unlike in the instant case, in none of those cases was it shown that the only novel feature of both patents was the same combination of old components.

In *Electric Storage Battery* v. *Buffalo* (117 F. 314), Judge HAZEL held at page 315:

> "None of them [expired patents] appear to include the invention claimed by the patent in suit, and only refer to it as may be necessary to describe the subsidiary invention."

and again at page 316:

> ". . . the expired patents are *improvements* on the unexpired generic patent."

and was affirmed by the Circuit Court of Appeals, Second Circuit (120 F. 672).

In re Carleton, 77 F. 2d 363, did not involve the question of extension of monopoly. The court said at page 365:

> "It is obvious from an examination of appellant's patent that it relates to an entirely different article of commerce than that defined by the claims here involved . . ."

The decision reaffirmed the well established rule which is applicable to the present case also (page 365):

> "that the obvious use of a patented invention did not entitle one to a patent for such use."

In re Coleman, 189 F. 2d 976, 979, merely reaffirmed *Palmer* v. *Lozier*:

> "If the claims are so related that the separately claimed element constitutes the essential distinguishing feature of the combination as claimed, different concepts are not involved, the inventions are not distinct, and double patenting will be found."

Palmer v. *Brown Mfg. Co.,* 92 F. 925, 929, the First Circuit Court of Appeals held that there was no double patenting because:

> "We are, upon the whole, of the opinion that the two patents are for two distinct inventions, and not for one invention;"

In *Thompson-Houston* v. *Sunday Creek,* on a motion for preliminary injunction, defendant did not oppose enforcement of the patent on the ground of extension of monopoly or double patenting. Judge Cross emphasized this:

> "It is *not* contended that the improvement patents are for the same invention as those of the original patent. A case of double patenting is *not,* therefore, presented."

In *Waterbury Buckle* v. *G. E. Prentice,* 294 F. 930, no extension of patent monopoly was found because the two patents were granted to two different persons. Judge Thomas said at page 937:

> "The two patents to Smith and Peller were not issued to one patentee. The fact that the patents

> were ultimately assigned to one and the same corporation does not, by any manner of means, make that corporation the same patentee ."

Furthermore, the Court held that the two patents which, of course, were not related as divisional and parent patents, covered essentially different inventions (pp. 938, 939).

In *Food Machinery Corp.* v. *American Fruit Machinery Corp.,* 64 USPQ 455, the expired patent and the patent in suit were granted to two different inventors (Jones and Lister). There was no suggestion that the two patents *claimed* the same invention.

In re Ferenci (83 F. 2d 279) dealt with the propriety of requiring an applicant to file a divisional application on claims defining a wrapping material severing device which may be employed with any machine, and leave in the parent application only claims on a special bread slicing and wrapping machine.

In *Dayton Fan* v. *Westinghouse,* 118 F. 562, on which Judge DENISON relied in the *Saranac* case, one of the patents was for a process and the other for the mechanical means by which an article could be produced and, therefore, unlike in the instant case, the facts did not fit the holding in *Palmer* v. *Lozier.*

In *Fehr et al.* v. *Activated Sludge, Inc.,* 84 F. 2d 948, the Circuit Court of Appeals for the Seventh Circuit held at page 953 that the patent in suit was not invalid for double patenting because:

> "We are convinced that the patents in suit do not fall within either the first or second type, for they do *not* disclose the same invention, and there could not be a dedication of a portion of the invention *not claimed* as between two or more applications when they were filed the same day."

The court at pages 956, 957, reaffirmed the rules laid down in *Miller* v. *Eagle* and the *Saranac* case.

Montgomery Ward & Co., Inc. v. *Gibbs,* 4th Cir., 27 F. 2d 469, holds that the question of double patenting is governed by the claims and not the disclosures of the two patents. The following is quoted from page 469:

> "It is not fatal if the invention of the second patent is disclosed in the earlier patent, provided it is not claimed there. . . . Where two applications are copending it is a matter of indifference which of the patents is issued first, provided the claims are for separate inventions."

Pierce patent 42 is invalid or cannot be enforced against the accused structures, not because it discloses the same invention as patent 96, but because it claims the same invention.

In *Crown Die & Tool Co.* v. *Nye Tool & Machine Works,* 261 U. S. 24, 35, the sole question before the court was whether the right to exclude persons from the making, using and vending of an invention was such an interest in a patent that it could be assigned. There was no holding that the public had any right under common law or otherwise to a patent while that patent was still in force.

Herman v. *Youngstown Car Mfg. Co.,* 191 F. 579, 584, 585, merely reiterated the well-known proposition that the mere fact that defendant's device was manufactured under a patent does not excuse him from infringement of another patent granted to plaintiff.

In *Grant* v. *Raymond* (6 Peters 218), the issue was whether the Secretary of State had the right to grant a new patent (what we would now call a reissue patent) to

replace an original patent which was surrendered as defective.

In *American Laundry Machine* v. *Prosperity,* C. A. 2, 295 F. 819, the separateness and distinctness of the inventions claimed in the divisional and parent patents was not even questioned. The sole issue before the court was whether a divisional application dated back to the date of filing of the parent application and the court held that it did.

In Re Hirschhorn, 162 F. 2d 489, CCPA, the majority of the Court of Customs and Patent Appeals affirmed the decision of the Patent Office requiring division between method and article claims. Associate Judge BLAND dissented, holding that the requirement was not necessary.